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Office of Director
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RJH
Paper No. 45

In re Application of:
HARLEY, JOHN B.
Serial No.: 07/867,819
Filed: April 13, 1992
For: Peptide Reagents for Diagnosis
Of Autoantibodies

DECISION ON PETITION

This is a decision on the petition, filed December 2, 1998. The petition, while being titled "Petition to Revive", has been treated here as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181. The delay in answering that petition is sincerely regretted.

On December 2, 1996, a non-final Office action was mailed to applicant. On that same day, applicant filed a paper. On October 31, 1997, a notice of abandonment was mailed to applicant which indicated that the application was abandoned for failure to respond to the December 2, 1996 Office action. In accordance with the petition, the notice of abandonment was received on November 7, 1997. On December 2, 1998, the present petition was filed.

Petitioner asserted that the December 2, 1996 paper that was filed by applicant constituted a response to the December 2, 1996 Office action. From this, petitioner concluded that the application was abandoned through inadvertent error by the Patent Office and, therefore, the abandonment should be withdrawn.

Petitioner's assertions are not persuasive for several reasons. First, 37 CFR 1.181(f) indicates that any petition not filed within 2 months from the action complained of may be considered untimely. Here, the petition was filed more than one year after the notice of abandonment was mailed and received. The petitioner indicated that after the notice of abandonment was received, phone calls were made to the Office to determine the status of the application. However, since the notice of abandonment was received on November 7, 1997 as admitted in the petition, the status of the application should have been clear. Thus, any petition to withdraw the holding of abandonment under 37 CFR 1.181 due to Office error should have been filed within two months from that date. For this reason, the petition is untimely. Second, it does not make sense to consider the paper filed on December 2, 1996 as a response to the Office action which was mailed on the same date. Clearly applicant could not have received the Office action, prepared a response, and filed the response all on the same day the Office action was mailed. As noted in


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the petition, the December 2, 1996 paper was filed in response to a telephone conversation with the examiner, not in response to the Office action. Third, the December 2, 1996 paper fails to address the 35 U.S.C. 112, second paragraph, rejection or the 35 U.S.C. 112, first paragraph, written description, rejection of the December 2, 1996 Office action. Furthermore, even if the Office action and the paper crossed in the mail, there is no PTO policy requiring a supplemental Office action, especially when the rejections made in the Office action still applied to the claims even as amended. Thus, applicant had an obligation to respond to the December 2, 1996 Office action.

In summary, for the reasons set forth above, the petition is untimely and the December 2, 1996 paper is not considered a response to the December 2, 1996 Office action. Since no response was filed, the application was appropriately abandoned. Accordingly, the petition is hereby denied.

PETITION DENIED.

Note, the application has been forwarded to the Office of Petitions for treatment of the petition as a petition to revive an abandoned application.


John Doll, Director
Technology Center 1600

PATREA L. PABST, ESQ.
ARNALL, GOLDEN, AND GREGORY
2800 ONE ATLANTIC CENTER
1201 WEST PEACHTREE STREET
ATLANTA, GA 30309-340